

REMARKS

In the Office Action dated March 18, 2004, claims 12 and 32 were objected to; claims 1, 3-7, 9-11, and 33 were rejected under 35 U.S.C. § 103 over Yoshimura in view of Kuo, Reuss, and Young; claims 8 and 34 were rejected under § 103 over Yoshimura in view of Kuo, Reuss, Young, and Blonder; claims 14, 15, 24-26, 29, 30, and 32 were rejected under § 103 over Chandler in view of Van Doorn; claims 8, 12-32, and 34-41 were rejected under § 103 over Livingston in view of Goodman, Yoshimura, and Blonder.

To establish a *prima facie* case of obviousness, at least the following two requirements must be established by the Examiner: (1) there must be some motivation or suggestion to combine the references; and (2) the references when combined must teach or suggest *all* elements of the claim. *See MPEP § 2143 (8th ed., Rev. 2) at 2100-129.* In the present case, neither requirement has been satisfied.

Claims 12 and 32 have been amended to address the objections.

Claim 1 recites a shield assembly for a *connector* that is connected to a port of a chassis, with the shield assembly having an electrically conductive cover defining a chamber *to enclose the connector*. The Office Action cited to Yoshimura as disclosing the electrically conductive cover that defines a chamber to enclose a connector. In particular, the Office Action identified insulating housing 20 (Figure 2 of Yoshimura) as being the connector, while the metal hood 40 and contact enclosing shell 30 of Yoshimura were identified as being the cover recited in claim 1. Applicant respectfully notes that the metal hood 40, insulating housing 20, and contact enclosing shell 30 are all part of the *connector* described in Yoshimura. *See Yoshimura, 2:49-52 ("In FIGS. 1 through 5, there is shown a connector 10 which includes a plurality of contact pins 11, an insulating housing 20, a contact enclosing shell 30, and an insulating molding 50.").* Thus, it is clear that Yoshimura teaches components of a connector, not a cover for a connector. All the other references, Kuo (cable and connector), Young (connector 12), and Reuss (RF shielded coupling), similarly disclose just a connector, not a cover for a connector. Therefore, even if the references can be combined, the hypothetical combination of Yoshimura, Kuo, Reuss, and Young do not teach or suggest each and

every element of claim 1. For at least this reason, a *prima facie* case of obviousness has not been established with respect to claim 1.

Moreover, there is simply no motivation or suggestion to combine the reference teachings. Yoshimura describes a connector where a metal hood 40 is attached to a contact enclosing shell 30 by locking means 60. *See* Yoshimura, Figure 1. The contact enclosing shell 30 protrudes from a flange 32 at the front of the connector. In Yoshimura, there does not appear to be any need or desirability of including an electrically conductive gasket that is electrically contacted to the cover and that is adapted to be placed between the cover and a chassis, nor is there any need or desirability of an attachment mechanism adapted to attach the cover to the chassis. A gasket would not be effective with the connector depicted in Yoshimura. In fact, if the gasket was placed adjacent the flange 32 depicted in Figure 1, such gasket would likely not even touch the chassis. There is no teaching by Yoshimura that the flange 32 is intended to touch a chassis. If the gasket were provided around the contact enclosing shell 30, the gasket would interfere with insertion of the contact enclosing shell into a connector provided in the system. In fact, if the gasket was provided around the outside of the contact enclosing shell 30, then insertion and removal of the connector into the port of a system would likely cause the gasket to be stripped from the surface of the shell 30. There does not appear to be any other surface of the connector depicted in Yoshimura that would provide any suggestion of any desirability or need to include a gasket or an attachment mechanism to attach the cover to a chassis.

It is well established law that “[t]he mere fact that the prior art could be so modified would not have made the modification **obvious** unless the prior art suggested the **desirability** of the modification.” *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (emphasis added). As the Federal Circuit has stated, “virtually all [inventions] are combinations of old elements.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). “Most, if not all, inventions are combinations and mostly of old elements.” *Id.* “Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’” *Id.*

The other references Kuo, Reuss, and Young do not provide any suggestion of modifying Yoshimura to incorporate a gasket into the Yoshimura connector. There simply does not exist any desirability of modifying the Yoshimura connector design to incorporate a gasket. Thus, it appears that the only basis for combining the elements of the four references is based on impermissible hindsight, where no suggestion or motivation existed at the time of the invention to combine the reference teachings.

Moreover, it is unclear what Reuss is intended to show. The Office Action stated that "Reuss applied, should issues arise, to show connector within a cover at 16, 2, 17. Obvious to similarly form the Yoshimura assemblies." 3/18/2004 Office Action at 2. The Office Action does not explain whether Reuss is to be used as a substitute for Yoshimura, or in addition to Yoshimura, Kuo, and Young. No explanation was provided regarding what features of claim 1 not found in the other references are taught or suggested by Reuss. Therefore, it is respectfully submitted that the inclusion of Reuss in the obviousness rejection is improper and should be withdrawn. Moreover, the connector depicted in Reuss is a standard connector design with a slotless shield 15 that is enclosed by a plastic sheath 21. Therefore, Reuss provides no additional teaching that would lead a person of ordinary skill in the art to the claimed invention.

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to the asserted combination of Yoshimura, Kuo, Reuss, and Young.

Dependent claims are allowable for these same reasons as claim 1. Moreover, with respect to new dependent claim 42, the asserted references to not disclose or suggest a cover that defines a chamber having a space to enclose the connector *without contacting* a housing of the connector. With respect to new dependent claim 43, the asserted

references do not disclose or suggest a cover that defines a chamber to enclose the connector that has an *electrically conductive* housing.

Independent claim 8 was rejected as being obvious over the asserted combination of Yoshimura, Kuo, Reuss, Young, and Blonder. Blonder was cited as teaching the piercing element recited in claim 8. However, Applicant notes that the asserted combination of Yoshimura, Kuo, Reuss, and Young does not disclose an electrically conductive cover that defines a chamber to enclose a connector, as explained above with respect to claim 1. Moreover, there is no suggestion or motivation to combine Yoshimura, Kuo, Reuss, and Young, in the manner proposed by the Office Action. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 8 for at least this reason.

The Office Action conceded that Yoshimura does not "include piercing means," but that Blonder "discloses the use of piercing means at 19'." 3/18/2004 Office Action at 2. It is respectfully submitted that there is no motivation or suggestion to modify the Yoshimura design to incorporate a piercing means as taught by Blonder. Yoshimura teaches that the sheath of the cable 70 is peeled off so that the shield member 72 is exposed. Yoshimura, 3:31-32. This enables the sleeve 47 of the metal hood 40 to be crimped to the shield member 72 of the cable 70. Yoshimura, 3:44-46. In other words, there is absolutely *no need or desirability* of incorporating the prongs described in Blonder in the Yoshimura connector. Therefore, no motivation or suggestion existed to combine Blonder with the other references to achieve the invention of claim 8.

Claim 8 was also rejected as being obvious over Livingston in view of Goodman, Yoshimura, and Blonder. As a preliminary note, although Goodman was asserted as being part of the combination of references, the Office Action has failed to provide any explanation of how Goodman contributes to a teaching or suggestion of the claimed invention. Therefore, for at least this reason, the obviousness rejection is defective as the rejection provides no explanation or support regarding how Goodman can be combined with Livingston, Yoshimura, and Blonder to achieve the claimed invention.

Moreover, there is no motivation or suggestion to combine Livingston, Goodman, Yoshimura, and Blonder, since Livingston describes direct contact between an outer shielding sheath 7 of the cable and the outer shielding shell 8, as depicted in Figure 2 of

Livingston. *See* Livingston, Figure 2 (elements 10, 11); 2:37-41 (a ferrule 11 securing the sheath 7 to a neck 10 of the shell 8). Note also that the material used for the shielding sheath 7 and shell 8 is a ferrous material such as galvanized steel. Livingston, 2:28-35. Galvanized steel has a coating formed of oxidized zinc that is electrically insulating. As explained in Livingston, the sheath 7 and shell 8 are designed to shield magnetic field, so electrical contact between sheath 7 and shell 8 is not required.

The cable of Livingston has its own separate shielding sheath for protection against electromagnetic leakage. Livingston, 2:24-27. However, clearly, it would be undesirable to electrically contact the cable shielding sheath 5 to the shell 8 or outer sheath 7, since the components serve different purposes. In fact, Livingston expressly teaches that an insulating layer 6 must be provided between the sheath 5 and the outer sheath 7 and shell 8. Therefore, there is absolutely *no need or desirability* to use the piercing means described in Blonder in the configuration of Livingston. Absent the requisite showing of motivation to modify Livingston, it is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness to combine Livingston with the teachings of Blonder, Goodman, and Yoshimura.

The Office Action also cited to part 47 of Yoshimura as somehow providing some suggestion to combine Livingston and Blonder. Note, however, that the element 47 of Yoshimura is a sleeve 47, and also, that Yoshimura teaches that the sheath of cable 70 is peeled off to expose conductors 71. The sleeve 47 of the metal hood 40 is then crimped to the exposed shielded member 72 of the cable for electrical connection. Yoshimura, 3:44-46. Thus, what Yoshimura teaches is that direct contact is made between a shell and a cable shield, thereby rendering useless the piercing means described in Blonder.

Withdrawal of the obviousness rejection of claim 8 over Livingston, Goodman, Yoshimura, and Blonder is respectfully requested in view of the foregoing remarks.

Independent claim 12 was also rejected as being obvious over the asserted combination of Livingston, Goodman, Yoshimura, and Blonder. This rejection is defective for the reason that no explanation is provided regarding how Blonder, Goodman, or Yoshimura can be combined with Livingston to achieve the invention of claim 12. The only explanation made in the rejection of claim 12 is reference to parts 17,

8, and 9 of Livingston, and that "claim 12 reads on two shield cable use as in Livingston." 3/18/2004 Office Action at 4. Therefore, the obviousness rejection of claim 12 over four references is defective for failure to explain how three out of the four references are applied to the claim.

Moreover, it is respectfully submitted that Livingston does not disclose or suggest the following combination of elements: a cable having a shield that is electrically connected to a connector housing, and a shroud that encloses the connector housing and having a cable engagement body to electrically contact *the* shield of the cable. In Figure 2 of Livingston, the shielding sheath 5 of a cable is shown electrically connected to the housing 17 of the connector. However, note that because of the presence of insulating sheath 6 depicted in Figure 2 of Livingston, the outer shielding shell 8 does not have the element (*see* element 10) that electrically contacts the shield 5 of the cable. In fact, Figure 2 of Livingston expressly shows an insulating layer 6 between the shell 8 and the cable shield 5. Although the outer shielding shell 8 is contacted to outer shielding sheath 7 around the outside of the cable, it is respectfully noted that the outer shielding sheath around the outside of the cable as depicted in Livingston *cannot* constitute the shield that is electrically connected to the connector housing, as the shielding sheath 7 is clearly spaced apart from the connector housing and it is isolated by various insulating layers from the outer shielding sheath 7. Therefore, no disclosure or suggestion is provided in Livingston of the subject matter of claim 12. A *prima facie* case of obviousness against claim 12 has thus not been established.

Claims dependent from claim 12 are allowable for at least the same reasons as claim 12. Moreover, with respect to dependent claim 20, 35, and 36, there is no suggestion or motivation to provide a piercing element, as taught by Blonder, in the connector assembly of Livingston.

Independent claim 14 was also rejected over the asserted combination of Livingston, Goodman, Yoshimura, and Blonder. With respect to claim 14, it is noted that Livingston fails to teach a shroud that is formed of an electrically conductive material, where the shroud is adapted to cooperate with the chassis and the cable shield to reduce electromagnetic leakage. It is noted that the shell 8 of Livingston is formed of a ferrous

material such as galvanized steel. Livingston, 2:28-50. Galvanized steel is steel provided with a protective oxidized zinc coating that is not electrically conductive. Therefore, the shell 8 of Livingston is unable to cooperate with a chassis and a cable shield to reduce electromagnetic leakage, since a non-conductive coating would prevent the formation of a good electromagnetic seal between shell 8 and sheath 7 to prevent electromagnetic leakage. None of the other references teach or suggest the shroud of claim 14. In view of the foregoing, it is respectfully submitted that Livingston and the other references fail to teach or suggest the subject matter of claim 14.

Claim 14 was also rejected over the asserted combination of Chandler and Van Doorn. As conceded by the Office Action, Chandler fails to disclose the recited shroud. 3/18/2004 Office Action at 3. However, the Office Action relied upon Van Doorn as teaching a shroud. Although Van Doorn teaches a strain relief boot 10 that includes an EMI shield, there is no teaching in Van Doorn that the cable engagement body of the shroud is capacitively connected to the cable shield through at least an outer insulating layer. Therefore, even if Chandler and Van Doorn can be properly combined, the hypothetical combination of Chandler and Van Doorn fails to teach or suggest at least one element of claim 14.

Claims dependent from claim 14 are allowable for at least the same reasons as claim 14.

Independent claim 24 was also rejected over either the combination of Livingston, Goodman, Yoshimura, and Blonder, or the combination of Chandler and Van Doorn. With respect to the rejection over the first combination of Livingston, Goodman, Yoshimura, and Blonder, it is respectfully submitted that the asserted references fail to teach or suggest electrically connecting a portion of the shroud to a cable shield, where the shroud cooperates with the cable shield to prevent electromagnetic leakage. The outer shielding shell 8 and the outer shielding sheath 7 of Livingston does not electrically connect to a cable shield. Moreover, because the outer shielding shell 8 and outer shielding sheath 7 is formed of a ferrous material such as galvanized steel, the shell 8 and sheath 7 of Livingston do not cooperate with a cable shield to prevent electromagnetic

leakage, since the shell 8 and sheath 7 of Livingston are designed to provide shielding for a magnetic field. None of the other references disclose the recited shroud.

With respect to the rejection over the second combination of Chandler and Van Doorn, it is respectfully noted that neither Van Doorn nor Chandler teaches or suggests electrically connecting a portion of a shroud to a cable shield. Therefore, the hypothetical combination of Van Doorn or Chandler fails to teach or suggest all elements of claim 24.

Claims dependent from claim 24 are allowable for at least the same reasons as claim 24.

Independent claim 29 was also rejected over both of the above two combinations of references. Claim 29 is allowable over the combination of references for similar reasons as those presented above.

Claims dependent from claim 29 are allowable for at least the same reasons as claim 29.

In view of the foregoing, all claims are in condition for allowance, which action is respectfully requested. The Commissioner is authorized to charge any additional fees, including extension of time fees, or credit any overpayment to Deposit Account No. 50-1673 (9793).

Respectfully submitted,

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